

REMARKS

The Examiner is thanked for the comments in the Action. They have helped us considerably in understanding the Action and in drafting this Response thereto.

5 It is our understanding that claims 1-34 remain pending in this application.

We proceed now with reference specifically to the numbered items in the Action.

Item 1: This is informational in nature and is understood to require no reply.

10 **Item 2 (Hyperlink):**

The Action here objects to the disclosure “*because it contains an embedded hyperlink and/or other form of browser-executable code (SPEC: Page 3 Para [0011]).*” Responsive hereto, paragraph [0011] is herein amended.

15 **Item 3 (Double patenting):**

All of the present claims are rejected under the judicially created doctrine of obviousness-type provisional double patenting as being unpatentable over the claims in Applicant’s copending U.S. Patent Application No 10/711,495. Respectfully this is error.

20 The Action here states that “*Although the conflicting claims are not identical, they are not patentably distinct from each other because (a) the instant application is directed toward an authentication of a email and the copending application is directed toward an authentication of a URL link.*” This is incorrect as stated. The instant application recites claims to “*determine whether an email comes from a purported originator.*” This is arguably authentication of the source of an email, whereas “*authentication of a email*” would mean to authenticate the content of an e-mail.

25 Next the Action asserts that “*the method of using a URL link to deliver an email is considered and recognized as obvious and well-known in the field at the time the invention was made.*” This is irrelevant. The present claims do not recite URL links and they do not recite elements to deliver e-mails. The present claims recite code segments, apparatus, and steps to process e-mails, regardless of how they are delivered.

30 Further, in the case of the ‘495 application, the claims recite code segments, apparatus

and steps that [1] listen for an activation of the hyperlink and [2] redirect to another URL. There is nothing analogous to these in the instant claims.

Item 4 (§ 102(e) rejections):

Claims 1, 3-10, 13-21, and 24-32 are rejected as being anticipated by Garib. Respectfully this is error.

Preliminary comments:

Briefly, it looks like the analysis in this Action is based on a conclusion that a purported message source is the actual message source if message integrity is established. For instance, most of the citations to the Garib reference are to where it is discussing message integrity. But one need look no further than the everyday counter example of spam e-mails to see that message integrity often establishes nothing about message origin.

In claim 1 a computer program of code segments is recited, the first segment works on “an authenticity mark including an originator identifier and encrypted data” and the second segment decrypts “said encrypted data based on said originator identifier.” From this it can be appreciated that an “originator identifier” and a set of “encrypted data” have a special relationship, because the “encrypted data” is decrypted based on the “originator identifier.” Thus, if I send the King of Denmark an e-mail with a false originator identifier representing that I am the Queen of England, the King will not be able to decrypt the encrypted data using that false identifier unless I somehow manage to provide a corresponding false set of encrypted data.

As a technical proposition, creating a false identifier and false encrypted data might seemingly be easy. In the abstract, it is (but that goes to the issue of utility rather than the present issues of novelty and obviousness). In the specific instance here, recall that claim 1 recites a computer program and consider how many possible variations of cryptography such might use. In practice, creating false pairs of originator identifiers and encrypted data that will get past a competently embodied computer program in accord with the present invention is not trivial.

Turning now to the text in the Action, it states “As per claim 1, Garib teaches a computer program ... for assisting a user to determine whether an email comes from a purported originator (Garib: Column 12 Line 60-63 and Column 16 Line 26-27: a claimed source of an email message is indeed a purported originator).” Respectfully, the citations do not

support the assertion. The first establishes only that computers and programs for them that work with e-mail exist, and the second cite here discusses alteration rather than origination.

Continuing, the Action asserts that [Garib teaches] “***a code segment that determines with a computerized system whether the email includes an authenticity mark including an***
5 ***originator identifier and encrypted data*** (Garib: [1] Column 12 Line 60-63, [2] Column 6 Line 30-35, [3] Column 16 Line 26-27 and [4] Column 7 Line 5-12 ...” However, these citations do not support the assertion. [1] establishes only that computers and e-mail programs exist; [2] and [3] discuss integrity rather than origination; and [4] appears to be in error, because it begins and ends mid-sentence in a paragraph discussing irrelevant aspects of e-mail standardization.

10 Continuing, the Action follows up the above assertions with the interpretive remarks that “... both of the claimed source (considered as an originator identifier) and the encrypted message hash value embedded on the email message.” However, this is wrong.

First, as discussed above, just because a party claims to be a source-originator does not mean they truly are. In the context of claim 1, Applicant’s “*originator identifier*” is a true
15 originator, or the encrypted data cannot be decrypted based on this and a lie or a technical failure is thus revealed.

Second, Applicant’s claims nowhere recite limitations related to a hash value. This appears to be an attempt at a technical argument that is simply irrelevant here, and this also appears to be directed to message integrity rather than determining message origination.

20 Continuing, the Action asserts that [Garib teaches] “***a code segment that decrypts said encrypted data based on said originator identifier, into decrypted data*** (Garib: Column 15 Line 20-23 ...” However, this citation merely discusses decrypting a conventional PKI digital signature, and this actually illustrates a major advantage of the present invention. Employing PKI digital signatures is impractical with e-mails in bulk and is simply impossible if recipients are not
25 set-up beforehand. In PKI a sender always needs a recipient’s public key before a message can be sent. The present invention is not subject to these limitations.

Continuing, the Action follows up the above assertions with the interpretive remarks that “... a data element is encrypted at the sender by using its private key (b) the receiving entity knows the corresponding public key of the sender and (c) the receiving entity decrypts the data to
30 ensure the validity of the received signature / encrypted hash value).” Respectfully, the Examiner’s remarks are enlightened but irrelevant here. The subject of hash values has already

been discussed. And while verifying a PKI signature is one way to establish whether a message comes from a purported source, it only works if other elements are present, like a trusted PKI certificate authority.

Continuing, the Action asserts that [Garib teaches] “*a code segment that presents ... whether the email includes said authenticity mark (Garib: Column 16 Line 23- 29); whether said encrypted data decrypts successfully; and information based on said authenticity mark and said decrypted data (Garib: Column 13 Line 51-59 ...*.” However, these citations strongly teach away from Applicant’s claimed invention. Here Garib is teaching the generation and matching of two hash values.

With respect to claims 3-10, these depend from claim 1 and we urge that they are allowable for at least the same reasons, as discussed above.

With respect to claims 13 and 24, these are a system and a method containing substantially the same limitations as claim 1. Claims 11-21 depend from claim 13 and claims 23-32 depend from claim 24. We respectfully urge that the rejections of claims 13-21 and 24-32 are error for at least the same reasons as claim 1, as discussed above.

Item 5 (§ 103(a) rejections 1 of 3):

Claim 2 is rejected as being unpatentable (obvious) over Garib in view of Dunnion. Respectfully this is error.

The Action here relies only on Dunnion to address the added limitation in claim 2, which depends from claim 1 and has all of its limitations. However, as shown above, Garib does not teach or reasonably suggest the elements/limitations of claim 1 and there are no apparent teachings in Dunnion that remedy this. Accordingly, we urge that the combination of Garib and Dunnion cannot support this rejection and that claim 2 is also allowable.

Item 6 (§ 103(a) rejections 2 of 3):

Claims 11, 22, and 33 are rejected as being unpatentable (obvious) over Garib in view of Connery. Respectfully this is error.

The Action here relies only on Connery to address the added limitation in claims 11, 22, and 33, which depend from claims 1, 13, and 24 and have all of their limitations. However, Garib does not teach or reasonably suggest the elements/limitations of claims 1, 13, and 24 and there are no apparent teachings in Connery that remedy this. Accordingly, we urge that the combination of Garib and Connery cannot support this rejection and that claims 11, 22, and 33 are also allowable.

Item 7 (§ 103(a) rejections 3 of 3):

Claims 12, 23, and 34 are rejected as being unpatentable (obvious) over Garib in view of Haitsuka. Respectfully this is error.

The Action here relies only on Haitsuka to address the added limitation in claims 12, 23, and 34, which depend from claims 1, 13, and 24 and have all of their limitations. However, Garib does not teach or reasonably suggest the elements/limitations of claims 1, 13, and 24 and there are no apparent teachings in Haitsuka that remedy this. Accordingly, we urge that the combination of Garib and Haitsuka cannot support this rejection and that claims 12, 23, and 34 are also allowable.

CONCLUSION

Applicant has endeavored to put this case into complete condition for allowance. It is thought that the objection has been corrected by amendment, that the §102 rejections are shown to be unfounded on the prior art reference cited, and that the §103 rejections have been completely rebutted. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all claims presently in the case be granted.

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Respectfully Submitted,



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